PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Uwe HEINELT et al.

Application No.: 09/734,008

Filed: December 12, 2000

For: SUBSTITUTED NORBORNYLAMINO DERIVATIVES, PROCESSES FOR THEIR PREPARATION, THEIR USE AS MEDICAMENTS OR DIAGNOSTICS, AND A MEDICAMENT COMPRISING THEM

Group Art Unit: 1614

Examiner: E. Sackey

Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In an Office Action dated October 10, 2001, the Office required restriction under 35 U.S.C. § 121 to one of Groups I-IX. Applicants provisionally elect to prosecute Group I, claims 1-6 and 35-37, with traverse.

Applicants traverse on the ground that it would not be unduly burdensome to search the subject matter of the claims as written. *See* MPEP § 803. This traversal is supported by the Office's own classification of the nine groups within only three classes (560, 564, and 514). Furthermore, although the Office attempts, at pages 3-4 of the Office Action, to show distinctiveness of the nine groups, it does not attempt to demonstrate that it would be a serious burden to examine all of the claims in this

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application. Specifically, the Office does not explain its rationale for its classifications of the nine groups, as is required. *See* MPEP § 803 at 800-4 (requiring an "appropriate explanation of separate classification" to support a *prima facie* showing of serious burden); *see also id.* § 808.02 ("[T]he examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation [separate classification]" (emphasis added)). As an initial matter, the Examiner has not explained why it would be a serious burden to examine claims 7-16 with the claims of Group I, since all of claims 7-16 would be examined in the same classes as Group I. Because the Office has not demonstrated a serious burden on the Examiner, it has not met one of the two criteria required for restriction. Accordingly, the restriction requirement should be withdrawn, especially as it is applied to Groups I-VI.

In the event the elected claims are found allowable, the Office is required to rejoin non-elected process and method claims which include all limitations of the composition claims. *See* MPEP § 821.04.

The Office also required election of a single disclosed species. *See* Office Action at 4. Applicants traverse this requirement, and provisionally elect the (+) enantiomer of example 6, namely (+)-(exo/endo)-(3-methoxybenzyl)(octahydro-4,7-methanoinden-5-yl) amine hydrochloride, on which at least claims 1-5 read.[1] Applicants respectfully traverse on the ground the Office's election requirement is improper because the claimed species in Markush claims 1-5 do not represent an unreasonable number of species. The MPEP states:

> If the members of the Markush group are sufficiently few in number . . . that a search and examination of the entire claim can be made

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[1] The other claims in this application also read on the elected species, if the other limitations of those claims are met.

> without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not . . . require restriction.

MPEP § 803.02 (emphasis added); *see also* 37 C.F.R. § 1.141(a) ("[M]ore than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application"). The Office has not demonstrated in the Office Action that the number of claimed species is unreasonable, or that there would be a serious burden to examine all of the claimed species.

Please grant any extensions of time required to enter this response and charge any required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: January 3, 2002

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